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OFFICE OF PETITIONS

In re Application of
Tom Van Horn et al.
Application No. 09/863,801
Filed: May 22, 2001
Attorney Docket Number: 22930-06067

ON PETITION

This is a decision on the petition under 37 CFR 1.183 to waive the rules and issue a refund of fees paid.

The petition under 37 CFR 1.183 is **DISMISSED**.

Petitioner contends that a Notice of Appeal was filed September 15, 2004 and that subsequently, on November 5, 2004, an amendment was filed and on November 10, 2005 the Appeal Brief was filed.

Petitioner argues however that an advisory action was issued on February 8, 2005 and that even though he disagreed with the Examiner's failure to enter the amendment, petitioner re-filed the Appeal Brief and also filed a request for a four month extension of time to prevent the abandonment of the application. Petitioner argues that the filing of the extension of time request was necessitated by the Examiner's delay in issuing a response to the amendment filed and that the extension of time fee and the fee for the instant petition should be refunded.

The argument and evidence supplied with the petition have been carefully considered, but are not persuasive.

Pursuant to both 37 CFR 1.116 and 37 CFR 1.135(b): (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. Accordingly, the filing of an amendment that does not place an application in condition for allowance will not extend the statutory period for reply, regardless of when the amendment is considered by the examiner, and will not prevent abandonment of the application. It is the applicant's

responsibility to take the necessary action in an application under a final Office action to provide a complete and proper reply. The fact that the examiner may not have an opportunity to review any amendment prior to the end of the period for reply does not relieve applicant of the responsibility to submit a complete and proper reply prior to the end of the statutory period for reply in order to avoid abandonment. In fact, the possibility of abandonment for failure to do so is precisely the possibility that applicants are cautioned of in §§ 1.116 and 1.135(b). Petitioner was not entitled to an advisory action prior to the end of the statutory period, nor should petitioner have relied on receiving one before taking action to save the application from abandonment.

Petitioner's contention that the Examiner caused or contributed additional attorney time and fees is not well taken. Petitioner requested and received an extension of time for the filing of the Appeal Brief, and the fees paid were required for the extension of time to do so. As well, the fees for the filing of the instant petition are required and thus cannot be refunded. It should be noted also that effective November 22, 2004, the petition fee has been increased from \$130.00 to \$400.00 and the extension of time fee has been increased from \$1530 to \$1590. Petitioner's deposit account has been charged in the amount of \$330 to cover the difference between the fees paid for the extension and the petition and that which is due. See the Notice published in the Federal Register on September 21, 2004 and in the Official Gazette of the United States Patent and Trademark Office on October 12, 2004.

This matter is being referred back to Technology Center 3627 for further examination.

Telephone inquiries related to this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
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Office of Petitions